

## REMARKS

In connection with Applicant's Request for Continued Examination (RCE), Applicant respectfully requests entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.114, and in light of the remarks which follow.

Claims 1, 3-27, 29-30, 32-55 and 57-58 and 60-61 are pending in the application, new claims 60-61 having been added above.

By the above amendments, Applicant amended claims 1 and 30 to further specify that the composition exhibits a SPF that is greater than a SPF exhibited by an identical composition that does not comprise spherical microparticles. Support for this amendment can be generally found at paragraph [0064] of the specification and in the Declaration of Dr. Martin Josso submitted on December 15, 2007. Applicant also amended claims 12-13, 21, 25, 30, 41-42, and 49-53 to address minor informalities and/or §112 issues. A claim that has been amended in a manner that does not narrow the claim's scope should be accorded its full range of equivalents. Finally, Applicant added new claims 60 and 61 to further define exemplary embodiments. Again, support for this claim can be found at least at paragraph [0064] of the specification and in the Declaration of Dr. Josso.

Applicant thanks the Examiner for the courtesies extended to its representative during the interview conducted on July 17, 2008. In particular, Applicant thanks the Examiner for indicating that favorable consideration would be given to Applicant's further claim amendments and remarks. Applicant also thanks the Examiner for withdrawing the obviousness-type double patenting rejection over copending Application No. 10/365,653.

Turning now to the Official Action, claims 12 and 41 (and other related dependent claims) stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

Although Applicant continues to believe that the claims as originally presented meet the requirements of §112, Applicant has amended the claims, where appropriate, to provide further clarification and expedite prosecution of the application. In particular, Applicant has deleted "bisbenzoazolyls" from claims 12 and 41 and deleted the term "derivatives" where appropriate from these and other related dependent claims.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the §112, second paragraph rejection.

Claims 1, 3-6, 9-18, 25, 29-30, 32-46, 53 and 58 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Iijima (U.S. Patent No. 6,258,857) in view of Fankhauser (U.S. 2002/0155073). Claims 1, 3-12, 14-25, 29-30, 32-41 and 47-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of Torgerson (U.S. Patent No. 6,458,906). Claims 26-27, 54-55 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iijima, in view of Torgerson and further in view of Candau (U.S. Patent No. 6,033,648). For at least the reasons that follow, withdrawal of the § 103 rejections is in order.

Independent claim 1, as amended above, recites a device comprising (A) a reservoir confining at least one composition intended for protecting the skin and/or hair against UV radiation, and (B) means to place said composition under pressure,

wherein said composition is in the form of simple or complex emulsion and comprises, in a cosmetically acceptable aqueous carrier:

(a) a photoprotective system capable of screening out UV radiation; and

(b) spherical microparticles of porous silica, wherein the composition exhibits a SPF that is greater than a SPF exhibited by an identical composition that does not comprise spherical microparticles of porous silica. (Emphasis added.)

Independent claim 30, as amended above, recites a composition suited for pressurization and intended for protecting the skin and/or hair against UV radiation, wherein said composition is in the form of a simple or complex emulsion and comprises, in a cosmetically acceptable aqueous carrier:

(a) a photoprotective system capable of screening out UV radiation; and

(b) spherical microparticles of porous silica, wherein the composition exhibits a SPF that is greater than a SPF exhibited by an identical composition that does not comprise spherical microparticles of porous silica. (Emphasis added.)

The Official Action asserts that each §103(a) rejection is maintained for the reasons set forth in the prior Official Actions. Applicant continues to respectfully disagree with the bases presented in the prior Official Actions.

Iijima relates to (1) a composition contained in the releasing container such as an aerosol container or pump-type releasing container, and used as being released from such container, and (2) a releasing container product containing such composition. (See Iijima at column 1, lines 5-11.)

Fankhauser relates to the use of mixtures of micronized organic UV filters for preventing tanning and for lightening human skin and hair and to their use in

cosmetic and pharmaceutical formulations. (See Fankhauser at column 1, paragraph [0001].)

To establish a *prima facie* case of obviousness, the prior art references (or references when combined) must teach or suggest all of the claimed features. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." See *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). See MPEP §2143.03.

Neither Iijima nor Fankhauser, alone or in combination, disclose or fairly suggest a device or composition comprising an emulsion and a photoprotective system capable of screening out UV radiation wherein the composition exhibits a SPF that is greater than a SPF exhibited by an identical composition that does not comprise spherical microparticles of porous silica, as recited in independent claims 1 and 30.

In particular, Applicant submits that Iijima is directed to concentrated internal liquid compositions in a releasing container. The disclosed composition is generally in the form of an aqueous lotion with dispersed particles of porous silica therein carrying an active compound. The particles are used in association with a synthetic resin and/or acrylic acid polymer in the presence of an alkaline agent. The active compound may be a perfume, an insect repellent, a deodorant, a plant extract, etc. Nowhere, however, does Iijima disclose or fairly suggest a device or composition as defined in independent claims 1 and 30 including the claimed combination of features.

Fankhauser does not overcome the deficiencies of Iijima.

Thus, the asserted combination of references does not establish a *prima facie* case of obviousness because it does not teach or fairly suggest all of the claimed features and fails to reflect a proper consideration of "all words" in the claims. Specifically, the asserted combination fails to reflect a proper consideration of "a simpler complex emulsion," "a photoprotective system capable of screening out UV radiation," "means to place said composition under pressure," and "wherein the composition exhibits a SPF that is greater than a SPF exhibited by an identical composition that does not comprise spherical microparticles of porous silica."

Applicant also submits that the Federal Circuit has established that evidence arising out of the so-called secondary considerations must always, when present, be considered en route to a determination of obviousness. Indeed, evidence of secondary considerations can be the most probative and cogent evidence in the record. It can establish that an invention appearing to have been obvious in light of the prior art was not. See *Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1983); and *Joy Technologies v. Quigg*, 14 U.S.P.Q.2d 1432, 1444 (D.D.C. 1990).

In this case, there is clearly no appreciation in any of the cited references, alone or in combination, of the unexpected and surprising advantages obtained by the claimed device and composition. In particular, the cited references, even in combination, fail to disclose or suggest that one could combine the specific features claimed to arrive at a device and/or composition exhibiting significantly increased sun protection factor (SPF). Applicant has provided remarks and test results in their prior responses demonstrating that the claimed subject combinations of features make it possible to significantly increase SPF by more than 100%. These remarks

are further supported by the Declaration of Dr. Martin Josso in which he explains that results he obtained show that the addition of spherical microparticles of porous silica to an emulsion containing a UV filter makes it possible to unexpectedly increase SPF by more than 100%.

Accordingly, even if the Official Action had established a *prima facie* showing of obviousness, which Applicant submits it has not, the unexpected results achieved by the claimed combination of features would rebut such a showing.

For at least these reasons, independent claims 1 and 30 are patentable over Iijima in view of Fankhauser. The remaining claims depend, directly or indirectly, from the rejected independent claims and are, therefore, also patentable over Iijima in view of Fankhauser for at least the reasons that independent claims 1 and 30 are patentable.

Torgerson relates to water and alcohol soluble or dispersible thermoplastic elastomeric copolymers and to cosmetic and pharmaceutical compositions containing these copolymers. (See Torgerson at column 1, lines 10-15.) Applicant submits that Torgerson fails to overcome the above-identified deficiencies of Iijima. Again, to establish a *prima facie* case of obviousness, the prior art references (or references when combined) must teach or suggest all the claimed features. Moreover, "all words in a claim must be considered in judging the patentability of that claim against the prior art." (See *In re Royka*, *In re Wilson* and MPEP §2143.03.)

The above-asserted combination of Iijima in view of Torgerson does not satisfy these requirements and, thus, does not establish a *prima facie* case of obviousness. The asserted combination does not disclose or fairly suggest a device or composition comprising the recited combination of features including an emulsion

and a photoprotective system capable of screening out UV radiation; there is no disclosure or suggestion of using a composition in the form of an emulsion comprising a photoprotective system capable of screening out UV radiation in combination with spherical microparticles of porous silica, wherein the composition exhibits a SPF that is greater than a SPF exhibited by an identical composition that does not comprise spherical microparticles of porous silica, as recited in claims 1 and 30. Accordingly, Iijima in view of Torgerson fails to disclose or fairly suggest the features of independent claims 1 and 30, and fails to reflect a proper consideration of all words in these independent claims.

Finally, even if the Official Action had established a *prima facie* showing of obviousness, the unexpectedly enhanced SPF resulting from the claimed combination of features rebuts any such showing. (See Dr. Josso's Declaration and the comparative test results presented in the tables in Applicant's response of August 14, 2006.)

For at least these reasons, claims 1 and 30 are patentable over the asserted combination of Iijima in view of Torgerson. Because the remaining claims depend, directly or indirectly, from independent claims 1 or 30, the remaining claims are also patentable over Iijima in view of Torgerson for at least the reasons that claims 1 and 30 are patentable. Reconsideration and withdrawal of the §103(a) rejection over Iijima in view of Torgerson are respectfully requested.

Candau relates to novel cosmetic and/or dermatological compositions comprising at least one iron oxide nanopigment, well suited for artificially tanning and/or darkening human skin to such extent as to resemble a natural tan. (See

Candau at column 1, lines 10-18.) Applicant submits that Candau fails to overcome the above deficiencies of Iijima and Torgerson.

In particular, the asserted combination of Iijima, Torgerson and Candau fails to establish a *prima facie* case of obviousness because the combination does not disclose or fairly suggest all of the features recited in the independent claims, which are necessarily present in rejected dependent claims 26-27, 54-55 and 57. The asserted combination fails to disclose or fairly suggest a device or composition comprising an emulsion and a photoprotective system capable of screening out UV radiation, wherein the composition exhibits a SPF that is greater than a SPF exhibited by an identical composition that does not comprise spherical microparticles of porous silica, as recited in independent claims 1 and 30. Accordingly, the asserted combination fails to disclose or fairly suggest these features of the independent claims and does not reflect a proper consideration of all words in the independent claims.

Finally, even if the Official Action had established a *prima facie* showing of obviousness, the unexpectedly enhanced SPF resulting from the claimed combination of features would rebut any such showing. (Again, see Dr. Josso's Declaration and the comparative test results presented in Applicant's response of August 14, 2006.)

For at least these reasons, claims 26-27, 54-55 and 57 are patentable over the asserted combination of references for at least the reasons that claims 1 and 30 are patentable. Reconsideration and withdrawal of the §103(a) rejection over Iijima, Torgerson and Candau are respectfully requested.



From the foregoing, Applicant earnestly solicits further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper or the application in general, the Applicant invites the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: September 18, 2008

By:

A handwritten signature in black ink, appearing to read "Martin A. Bruehs", is written over a horizontal line.

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